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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
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EWB  
Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re K.C.P.L., Inc.

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Serial No. 75/790,857

Howard N. Aronson for K.C.P.L., Inc.

Ellen Awrich, Trademark Examining Attorney, Law Office  
113 (Meryl Hershkowitz, Managing Attorney).

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Before Hanak, Hairston and Wendel, Administrative  
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge.

K.C.P.L., Inc. (applicant) seeks to register KENNETH  
in typed drawing form for the goods listed below. The  
intent-to-use application was filed on September 2, 1999.

cosmetics, namely, makeup, compacts, cosmetic  
pencils,  
eye makeup remover, non-medicated lip balm, beauty  
masks, facial scrubs, skin soap, bath gel, bath  
salts,  
shampoo, non-medicated hair care preparations;  
shaving  
cream, shaving balm; baby, bath, body and massage  
oils;  
skin lotion; body, eye, hand and skin cream, baby  
and  
face powder; deodorants and antiperspirants;  
fragrances

namely, perfumes, colognes and toilet water; sun screen

preparations in International Class 3.-

coats, jackets, overcoats, rainwear and topcoats, suits, blazers, shirts, slacks, dresses, sweaters, jeans, t-shirts, sweatshirts, swim wear, shorts; underwear, loungewear, lingerie, robes and pajamas; neckwear, scarves, gloves, mittens, headwear, belts; footwear, socks and hosiery in International Class

25.-

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With regard to applicant's International Class 3 goods, the Examining Attorney has refused registration pursuant to Section 2(d) of the Trademark Act on the basis that applicant's mark, as applied to applicant's goods, is likely to cause confusion with the identical mark KENNETH previously registered on two occasions in typed drawing form to the same entity. The first registration is for "hair spray." Registration No. 767,981. The second registration encompasses, among other goods, "moisture lotion, foundation make-up, filled compacts, make-up remover, hair spray, hair setting lotion, hair conditioner, perfume, cologne and hair shampoo." Registration No. 918,342.

With regard to applicant's International Class 25 goods, the Examining Attorney has refused registration pursuant to Section 2(d) of the Trademark Act on the basis that applicant's mark, as applied to applicant's

goods, is likely to cause confusion with the mark KENETH KNITS, previously registered in the form shown below for "knitted tops." Registration No. 1,148,983.

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When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.")

Considering first the refusal with regard to

applicant's International Class 3 goods, this case presents a most unusual situation in that applicant seeks to register the identical mark KENNETH for goods which, in part, are identical to the goods of Registration Nos. 767,981 and 918,342. To be more precise, applicant seeks to register KENNETH for "non-medicated hair care preparations," a term broad enough to encompass "hair spray" (the sole good of cited Registration No. 767,981) and "hair spray, hair setting lotion and hair conditioner" (some of the goods of cited Registration No. 918,342). In addition, applicant

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seeks to register KENNETH for, among other goods, "makeup, compacts, eye makeup remover, shampoo, perfumes and colognes." These goods are identical to certain of the goods encompassed within cited Registration No. 918,342, namely "foundation make-up, filled compacts, make-up remover, hair shampoo, perfume and cologne."

Given the fact that applicant seeks to register the identical mark KENNETH for goods which are, in part, identical to the goods of the two cited registrations owned by the same entity, confusion is not merely likely,

but rather it is an absolute certainty. At page 2 of its brief, applicant argues that "even marks which are identical ... may create sufficiently different commercial impressions when applied to the respective party's goods so that there is no likelihood of confusion." Even assuming for the sake of argument that applicant's premise is correct, the flaw in applicant's logic is that applicant seeks to register the identical mark KENNETH for goods which are, in part, identical to the goods of Registration No. 767,981 and to certain of the goods of Registration No. 918,342. At page 3 of its brief, applicant argues that goods identified in Registration Nos. 767,981 and 918,342 are "only available at

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the Kenneth Beauty Salons & Products store located in Manhattan in New York." Even assuming the correctness of this statement, what applicant fails to realize is that these two registrations contain no such restrictions on where the goods may be distributed. In Board proceedings, "the question of likelihood of confusion must be determined based on an analysis of the mark as

applied to the goods and/or services recited in applicant's application vis-a-vis the goods and/or services recited in [registrant's] registration, rather than what the evidence shows the goods and/or services to be." Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

As for applicant's argument at page 4 of its brief that "cosmetic consumers are sophisticated purchasers," applicant qualifies this argument by assuming that the products listed in its application and the products listed in the two cited registration are "high-end cosmetic products." Applicant's application and the two cited registrations contain no such limitation. Moreover, if such a limitation appeared in the application and the two cited registrations, we would find that even the most sophisticated consumers could not

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distinguish applicant's products from registrant's products when the marks are identical and the goods are, in part, identical.

Finally, at pages 4-7 of its brief, applicant notes that there are a number of registrations containing the

name KENNETH which encompass various types of goods in International Class 3. However, all of these various marks are not for KENNETH per se, but rather are for KENNETH combined with a surname or some other distinguishing matter.

We turn now to the refusal to register applicant's mark KENNETH for various types of apparel in International Class 25 based upon Registration No. 1,148,983 for KENETH KNITS for "knitted tops." Two of applicant's International Class 25 goods are "shirts and sweaters." Obviously, shirts and sweaters can be knitted, and thus are knitted tops. Indeed, the word "sweater" is defined as "a knitted or crocheted outer garment for the upper body." Webster's New World Dictionary, (1996). Thus, the goods of cited Registration No. 1,148,983 (knitted tops) encompass certain of applicant's goods, namely, sweaters and at least certain types of shirts.

Considering next the marks, we note at the outset that

when the goods are at least in part legally identical as

is the case here, "the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). In comparing marks, we are obligated to compare the marks in their entireties, including any matter which is descriptive. American Home Products v. B. F. Ascher, 473 F.2d 903, 176 USPQ 532, 533 (CCPA 1973). However, there is nothing improper in comparing marks to give more weight to the dominant element of the mark consisting of two or more words. In the case of the cited mark, KENETH KNITS, the arbitrary word KENETH clearly dominates over the disclaimed, descriptive word KNITS. 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 23:45 at page 23-99 (4th ed. 2001). A consumer familiar with registrant's mark KENETH KNITS on knitted tops, upon seeing applicant's mark KENNETH on sweaters and knitted shirts, could well assume that both applicant's products and registrant's products emanate from a common source. Said consumer would be of the belief that in some instance the common manufacturer of the knitted tops (which include sweaters and



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certain shirts) simply decided to use KENETH (or KENNETH) per se, and in other instances elected to include the generic term KNITS. Moreover, we do not believe that ordinary purchasers of knitted tops (which includes sweaters and certain shirts) would notice that registrant depicts KENETH with one N whereas applicant depicts KENNETH with two Ns.

Finally, applicant goes on to make similar arguments as to why there is no likelihood of confusion with regard to its International Class 25 goods as it did with regard to its International Class 3 goods. Put quite simply, our comments with regard to these arguments are the same.

Decision: The refusal to register is affirmed both as to applicant's International Class 3 goods and applicant's International Class 25 goods.

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